REMARKS

This amendment is responsive to the Office Action dated August 1, 2001.

Claims 7-26 have been canceled, without prejudice. Claims 10 and 13 have been

rewritten in the independent form. Claims 27-40 have been added for consideration.

Reconsideration of the objections and rejections contained in the Office Action is

hereby requested.

1.   Request for Information Under 37 CFR 1.105

The Office Action requested certain information under 37 CFR 1.105. Attached

to this Amendment is a Disclosure Under 37 CFR 1.105 in compliance with the request.

2.   Double Patenting

Claims 7, 8, 12 and 15-19 were rejected under the judicially created doctrine of

obviousness-type double patenting over claims 1-21 of United States Patent No.

6,219,694, from which this present application is a continuation. These claims have

now been canceled.

3.   Rejections Under Section 112

Claims 9 and 20 were rejected under section 112, first paragraph. Claims 9 and

20 have now been canceled.

4.   Rejections Under Sections 102 and 103

   A.   Summary of Rejections

Claims 7, 8, 10, 12 and 13 were rejected under section 102 as being anticipated by United States Patent No. 6,052,735 to Ulrich ("Ulrich"). Claim 14 was rejected under section 103 as being obvious over Ulrich in view of United States Patent No. 6,034,621 to Kaufman ("Kaufman"). Claims 7-9, 11, 13 and 15-19 were rejected as being obvious in view of United States Patent No. 5,764,639 to Staples ("Staples") in view of United States Patent No. 6,101,531 to Eggleston ("Eggleston"). Claim s 20-26 were rejected under section 103 over Staples, Eggleston and several other prior art references. Claims 10, 13 and 14 were not rejected over Staples.

   B.   Summary of Analysis

Claims 10, 13 and 14 remain in the application. Claims 7-9, 11-12 and 15-26 have been canceled and thus further discussion of these claims with respect to Staples or Eggleston is unnecessary. Claims 10, 13 and 14 are patentable over Ulrich and Kaufman because, as demonstrated below and by the attached Affidavit of Prior Invention under 37 CFR 1.131, neither of these references is prior art to the present application. These claims are therefore in condition for allowance. New claims 27-40 have been added and clearly distinguish from Staples and thus are also in condition for allowance. Reconsideration is respectfully requested.

C.   Ulrich and Kaufman are Not Prior Art

Claims 10, 13 and 14 were rejected primarily over Ulrich.   These claims were not rejected over Staples, and thus Staples is not an issue with respect to the patentability of these claims. (MPEP § 707.07(g)) Claims 10 and 13 were rejected as being anticipated by Ulrich, and claim 14 was rejected over Ulrich in view of Kaufman. Claims 7, 8 and 12 were also rejected over Ulrich.

Ulrich and Kaufman are not prior art to the present application. Attached to this Amendment is an Affidavit under 37 CFR 1.131, which establishes that the present invention was conceived of prior to the earliest effective filing dates of either Ulrich or Kaufman, and that the inventors then diligently worked towards reducing their invention to practice and filing the parent application to this application. Therefore, the rejections over Ulrich must be withdrawn. Since there are no remaining rejections of claims 10, 13 and 14, an indication of allowability is respectfully requested.

D.   Staples Does Not Anticipate or Render Obvious the New Claims

Claims 7-9, 11, 12, and 15-26 were rejected under section 103 primarily over Staples. In rejecting these claims, the Patent Office primarily relies on a portion of the Staples patent that indicates that a remote user can establish a "virtual presence" at their corporate office so that the remote user can send and receive phone calls, faxes, email, etc., "as if he were physically present at the corporate office." (Staples, col. 6, ll. 22-25; col. 23, ll. 11-13) The methodology described in Staples, however, is dramatically different from the system and method described in the present application.

In fact, Staples is just another example of a "pull synchronization" system, in which the remote user must connect to the host system in order to obtain any relevant information stored at the host system, and once disconnected, is no longer synchronized with the host. These types of systems, and there shortcomings, were discussed in detail in the Background section of the present application. These rejections are respectfully traversed.

Because these claims have been canceled, however, further discussion of the rejections in relation to this claims is unnecessary. An understanding of Staples is necessary to appreciate the distinctions between Staples and the new claims 27-40.

i.   The Staples System

Staples discloses a system and method for providing a remote user with a virtual presence to an office so that the remote user can behave substantially as if the user were physically present at the corporate office. (Abst.) This is accomplished using "virtual presence" software operating at the remote device, and at a "virtual presence server." (Abst.; FIG. 2) The virtual presence server (106) is then coupled to various other systems at the corporate office, such as a PBX system (112) for receiving phone calls, and the corporate LAN (114) for receiving data. (Abst.; FIG. 2)

Staples discloses only one method for achieving this "virtual presence" -- by causing the remote device to dial into and create a "connection" to the virtual presence server. (Staples, col. 2, ll. 38-49):

> "When the remote user desires to establish a virtual presence at
> the corporate office, *the remote user dials the virtual presence*
> *server and establishes a connection. This includes providing*
> *identification information and security information to the virtual*

presence server. Once the remote user is connected, the virtual presence server instructs the corporate PBX to automatically forward all calls to the remote user. The virtual presence server also routes email, faxes, and LAN data to the remote user." (emphasis added)

Without this "connection" being established between the remote device and the virtual presence server, there is no forwarding of information to the remote device. Thus, like the "pull synchronization" systems described in the Background section of the present application, "the two systems (host and mobile) only maintain the same data items after a user-initiated command sequence that causes the mobile device to download the data items from the host system." (Background, at 3)

The requirement of a "connection" between the remote device and the virtual presence server is described throughout Staples:

> "First the remote user establishes a virtual presence at the corporate office, including providing identification and security. *Once the remote user is connected, the virtual presence server instructs the corporate PBX to automatically forward all calls to the remote user.*" (Abstract; emphasis added)

> "The user [at the remote unit] preferably clicks the mouse on the 'Be There' icon *to establish a connection between the remote computer system and the corporate office.* Clicking the mouse button on the 'Be There' icon invokes an autodial routine, and the autodial routine operates *to provide a connection between the remote computer system and the corporate office.*" (Col. 17, lines 1-7; emphasis added)

> "In step 568 the virtual presence software establishes a connection with the virtual presence server." (Col. 21, ll. 8-10)

> "Therefore, *once the remote user has been connected to the corporate office,* the remote user operates substantially as if the user were physically present at the corporate office." (Col. 23, ll. 30-32)

Put simply, Staples is describing a remote login and control system for a remote device so that the user of the remote device can gain access to information at their corporate office.

<p style="text-align:center;">ii.   <u>New Claims 27-40 are Patentable over Staples</u></p>

New claims 27-40 have been added. These claims are clearly distinguishable from Staples. For example, claim 27 recites a method in a mobile communication device for generating and addressing originated messages and reply messages, where the mobile device operates in conjunction with a host system having a redirector component. The mobile device determines whether the redirector component at the host system is activated, and addresses the original or reply messages accordingly. Support for these claims is set forth in FIG. 5 of the present application, and accompanying description.

The prior art of record, including Staples, simply does not disclose these steps for generating and addressing messages at a mobile device. In Staples, messages are generated at the virtual presence server, not at the mobile device, and there is simply no disclosure in Staples of the selective enveloping/addressing scheme set forth in these new claims. This claim is therefore in condition for allowance.

Claims 28-35 depend from claim 27 and are thus allowable for at least the same reasons as claim 27. Claims 36-39 include similar steps to claim 27, in that they relate to the selective packaging/addressing of messages at the mobile device. Claim 40 relates to a selective messaging system in which messages are generated at the mobile device which may be transmitted either through a host system, in which case the

<p style="text-align:center;">16</p>

message appears to have originated from the host system, or directly from the mobile device to a message recipient. This type of selective mobile device messaging system is not described in Staples, or any of the other prior art references of record in this case. Therefore claim 40 is also in condition for allowance.

5.   Conclusion

All of the pending claims are in condition for allowance. There are no outstanding rejections for claims 10, 13 and 14. This Amendment has demonstrated that the new claims are clearly distinguishable from Staples. A notice of allowance is respectfully requested.
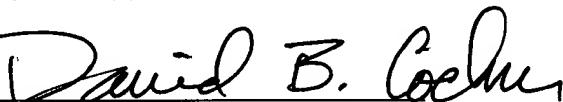
Attached hereto is a marked-up version of the changes made to the claims by this Amendment.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please cancel claims 7-9, 11-12 and 15-26.

Please amend the remaining claims 10 and 13 as follows:

10. (Amended) [The mobile communications device of claim 7] A wireless mobile communications device associated with a first computer system identified by a first electronic address, wherein the first computer system includes a wireless redirector component for continuously redirecting messages, as they are received, from the first computer system to the wireless mobile communications device, comprising:

      a receiver for receiving a redirected message from the first computer system;

      a memory for storing the redirected message;

      a message generator for generating a reply message to the redirected message at the mobile device, wherein the reply message is addressed using the first electronic address of the first computer system as an originating address of the reply message; and

      a transmitter for transmitting the reply message to the first computer system, wherein the first computer is the user's desktop computer system.

13. (Amended) [The mobile communications device of claim 7, further comprising] A wireless mobile communications device associated with a first computer system identified by a first electronic address, wherein the first computer system includes a wireless redirector component for continuously redirecting messages, as they are received, from the first computer system to the wireless mobile communications device, comprising:

a receiver for receiving a redirected message from the first computer system;

a memory for storing the redirected message;

a message generator for generating a reply message to the redirected message at the mobile device, wherein the reply message is addressed using the first electronic address of the first computer system as an originating address of the reply message;

a transmitter for transmitting the reply message to the first computer system; and

a redirector component for redirecting messages received at the mobile communications device to the first computer system.

Please add the following new claims:

-- 27. (New) A method in a mobile communication device, comprising the steps of:

providing an electronic address of a host system at the mobile communication device, wherein the host system includes a redirector component for redirecting messages to the mobile communication device;

generating an original message at the mobile communication device, wherein the original message is addressed to a message recipient and from the electronic address of the host system;

determining whether the redirector component is activated at the host system;

if the redirector component is activated, then packaging the original message into an electronic envelope addressed to the host system and transmitting the electronic envelope from the mobile communication device to the host system; and

if the redirector component is not activated, then transmitting the original message from the mobile communication device directly to the message recipient. --

-- 28. The method of claim 27, further comprising the steps of:

receiving a message at the mobile communication device;

determining whether the message is a redirected message from the host system or a message from a message sender;

if the message is a redirected message from the host system, then removing an outer envelope from the redirected message to recover a message from a message sender, and displaying the message on the mobile communication device; and

if the message is from a message sender, then displaying the message on the mobile communication device. --

-- 29. (New) The method of claim 28, further comprising the steps of:

generating a reply message at the mobile communication device, wherein the reply message is addressed to a message recipient and from the host system;

determining whether the redirector component is activated at the host system;

if the redirector component is activated, then packaging the reply message into an electronic envelope addressed to the host system and transmitting the electronic envelope from the mobile communication device to the host system; and

if the redirector component is not activated, then transmitting the reply message from the mobile communication device directly to the message recipient. --

-- 30. (New) The method of claim 27, further comprising the step of:

configuring one or more redirection events at the host system, wherein at least one of the redirection events includes a message from the mobile communication device to begin continuously redirecting messages from the host system to the mobile communication device. --

-- 31. (New) The method of claim 30, further comprising the step of:

altering the configuration of the redirection events at the host system by transmitting a command message from the mobile device to the host system. --

-- 32. (New) The method of claim 27, further comprising the step of:

generating messages at the mobile communication device, wherein the messages generated at the mobile communication device are addressed using the electronic address of the host system. --

-- 33. (New) The method of claim 27, further comprising the steps of:

receiving a redirected message from the host system at the mobile communication device, wherein the redirected message includes an indication that an attachment was coupled to the redirected message, but was not redirected to the mobile communication device;

transmitting a command message from the mobile communication device to the host system instructing the host system to transmit the attachment to the mobile communication device. --

-- 34. (New) The method of claim 27, further comprising the steps of:

receiving a redirected message from the host system at the mobile communication device, wherein the redirected message includes an indication that an

attachment was coupled to the redirected message, but was not redirected to the mobile communication device;

transmitting a command message from the mobile communication device to the host system instructing the host system to transmit the attachment to an external device capable of processing the attachment. --

-- 35. (New) The method of claim 27, wherein the host system includes a preferred list for limiting the redirection of messages to the mobile communication device based on redirection parameters stored in the preferred list, the method further comprising the step of:

transmitting a command message from the mobile communication device to the host system to alter the redirection parameters of the preferred list. --

-- 36. (New) A method in a mobile communication device, comprising the steps of:

providing an electronic address at the mobile communication device that is representative of a user's electronic mail account at a host system, wherein the host system includes a component for sending and receiving messages to the mobile communication device;

generating a first message at the mobile communication device, wherein the first message is addressed to a message recipient and from the electronic address at the host system;

if the first message is to be sent via the host system, then packaging the first

message into an electronic envelope addressed to the host system and transmitting the

electronic envelope from the mobile communication device to the host system,

otherwise transmitting the first message from the mobile communication device directly

to the message recipient. --

-- 37. The method of claim 36, further comprising the steps of:

receiving a second message at the mobile communication device;

determining whether the second message is a redirected message from the host

system or a message from a message sender;

if the message is a redirected message from the host system, then removing an

outer envelope from the redirected message to recover a message from a message

sender, and displaying the message on the mobile communication device; and

if the message is from a message sender, then displaying the message on the

mobile communication device. --

-- 38. (New) The method of claim 37, further comprising the steps of:

generating a reply message at the mobile communication device, wherein the

reply message is marked with a redirection flag, and addressed to a message recipient

and from the host system;

if the redirection flag is activated, then packaging the reply message into an electronic envelope addressed to the host system and transmitting the electronic envelope from the mobile communication device to the host system; and

if the redirection flag is not activated, then transmitting the reply message from the mobile communication device directly to the message recipient. --

-- 39. (New) A method associated with a mobile communication device operated by a mobile user, the mobile communication device capable of sending and receiving messages via multiple message paths, the method comprising the steps of:

providing an email address for the mobile communication device that is also the mobile user's email address at the mobile user's office computer system;

providing a wireless network address for the mobile communication device;

generating a message at the mobile communication device, wherein the message is addressed to a message recipient;

if the message is associated with the mobile user's email address at the mobile user's office computer system, then

transmitting the packaged message from the mobile communication device, via a wireless network, to the office computer system, which in turn sends the message to the recipient, wherein the message uses the email address as a sent from address thereby associating the mobile user's email address at the mobile user's office computer system; otherwise,

transmitting the message from the mobile communication device directly

to the message recipient without sending the message to the office computer system. --

-- 40. (New) A method associated with a mobile communication device capable of sending and receiving messages via multiple message paths, the method comprising the steps of:

providing an email address for the mobile communication device that is also the mobile user's email address at the mobile user's office computer system;

generating a first message at the mobile communication device, wherein the first message is addressed to a message recipient and from a message sender;

generating a second message at the mobile communication device, wherein the second message is addressed to a message recipient and from a message sender;

transmitting the first message from the mobile communication device, via a wireless network, to the office computer system which in turn sends the message to the recipient, wherein the message uses the email address as the originating address of the message sender;

transmitting the second message from the mobile communication device, via the wireless network, directly to the message recipient without first sending the message to the office computer system. --